



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL NO.

ATTORNEY DOCKET NO. 428191

Applicants: Daniel M. Eggert et al.
Title: MAGNETIC BIT HOLDER AND
TOOL INCORPORATING SAME
Serial No. 09/110,145
Filing Date: July 2, 1998
Group Art Unit: 3723
Examiner: D. Meislin
Date: June 28, 2000

PATENT

Reply Brief
#12
B. Ross
10/3/00

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REPLY BRIEF OF APPLICANTS

In the Examiner's Answer, the examiner agrees with the following statement from the CAFC's decision in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

"The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application." (Emphasis in original).

By not questioning it, the examiner has also tacitly agreed with the CAFC's holding in *In re Clement*, 35 USPQ2d 1161, 1165 (Fed.Cir. 1997) that:

"If the reissue claim is narrower in an aspect germane to prior art rejection and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim...."

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Irene Keigulov
Date: 9/25/00

In other words, if a reissue claim is broader only in aspects unrelated to the prior art rejection in the original application, it is not “broader” for purposes of the recapture rule.

Nevertheless, the examiner contends that the recapture rule applies in this case, because reissue claims 15 and 22 “are clearly of broader scope than those claims that were canceled from the original application since the recitation ‘retaining member being generally bowl-shaped and convex toward said magnet’ was eliminated from these claims.” (Emphasis in original). The difficulty with the examiner’s argument is that the examiner is comparing claims 15 and 22, not to a claim which was “canceled” from the original application, as required by the *Ball* decision, but rather to a claim which was added to the original application and issued in the original patent. The fact that the “generally bowl-shaped and convex toward said magnet” limitation is eliminated from claims 15 and 22 of the reissue application is beside the point. The point is it was not eliminated from any claims during the prosecution of the original application.

For reasons explained in detail in applicants’ main brief, applicants are not attempting in this reissue to resurrect a claim scope which was effectively canceled in the original application and, therefore, the recapture rule does not apply.

Respectfully submitted,



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September 25, 2000

Assistant Commissioner for Patents
Washington, D.C. 20231

Re: Snap-on Technologies, Inc.
Matter No. 428191
Patent Application for:
MAGNETIC BIT HOLDER AND
TOOL INCORPORATING SAME
Filed: July 2, 1998
Serial No. 09/110,145

Sir:

Transmitted herewith for filing is a Reply Brief of Applicants, in triplicate, and Request for Oral Hearing in the above-captioned application, sent with Certificate of Mailing thereon.

Enclosed is our check in the amount of \$260 in payment of the oral hearing request fee.

Please charge any additional fees or credit any over-payment incident to the filing of this document to Deposit Account No. 19-1351. This letter is enclosed in duplicate.

Sincerely yours,

Jerry Stratman
Terry Stratman

JTS:if

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REQUEST FOR ORAL HEARING

The Patent Owner hereby requests an oral hearing of this appeal. Submitted herewith is our check in the amount of \$260 in payment of the hearing fee.

Respectfully submitted,

J. Terry Stratman
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Date: 9/25/00

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